

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s): Allen, et al.

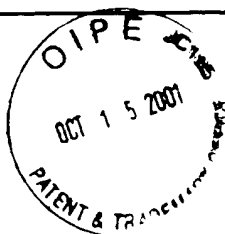
Application No.: 09/737,687

Filed: 12/14/2000

Title: SALICYLAMIDES AS SERINE PROTEASE INHIBITORS

Attorney Docket No.: 218

Assistant Commissioner for Patents
Washington, D.C. 20231



Group Art Unit:
1626

Examiner:
WRIGHT, S.

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

This will respond to the Election/Restriction Requirement of July 30, 2001, in the above-identified application. Enclosed under separate cover is a petition to extend the time to file this response.

The Examiner restricted the Applicants' invention in the following manner:

- I. Claims 1-8 and 10-17 drawn to compounds of formula I, classified in various classes and subclasses.
- II. Claims 20-27, drawn to a process, classified in various classes and subclasses.
- III. Claims 9, 18, 19 and 28-31, drawn to a method of use, classified in various classes and subclasses.

Based on the July 30, 2001 Action, the Applicants understand the Examiners position to be as follows:

The Examiner has taken the position that the above groups are distinct, each from the other, because they differ in structure and/or element so as to be patentably distinct. The Examiner accordingly has required the Applicants to elect one of the above three groups. Further, the Examiner has taken the position that the above groups themselves are inclusive of patentably distinct subject matter and requires the Applicant to elect a single disclosed species. The Applicants, therefore, elect Group I, claims 1-8 and 10-17 and the species of page 66, line 8. The Applicants understand their election to mean that claims 1-8 and 10-17 will be examined to the extent that such claims read on the compounds of the elected species. The Applicants further understand their election to mean that if, after examination on the merits, the elected Markush group members are found to be patentable, then the examination will be extended to the other

Markush group members set forth in Group I. If the Applicants have misinterpreted the intent of the Examiner with regard to the Restriction Requirement and to the extent that the Examiner anticipates that the Applicants will be required to amend their generic claims, prior to an allowance, so as to excise the non-elected subject matter of claim 1, then the Applicants respectfully traverse this Restriction Requirement for the following reasons:

If, in order to comply with the Restriction Requirement, the Applicants are compelled to divide their generically claimed invention into various subgenus claims, the Applicants will not have their claims examined in the form that they believe to best define their invention. Decisions by the Patent and Trademark Office Board of Patent Appeals and its reviewing court clearly hold that a restriction requirement which compels an applicant to divide a generic claim for the purposes of excising non-elected subject matter is improper and that such a procedure amounts to a rejection. The Applicants cite *In re Haas II*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978) and *In re Weber*, 580 F.2d 455, 198 USPQ 331 (CCPA 1978), in support of this position. The court in *In re Weber*, summarized the law as follows:

“As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on the merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification.”

On appeal from the Board's decision, the Court of Custom and Patent Appeals held that an adverse action of this nature is a rejection and denial of substantive rights, review of which must fall within the jurisdiction of the Board. The Court remanded the case to the Board, which remanded the case to the examiner and the examiner then finally rejected the claims for misjoinder of invention under 35 U.S.C. § 121. On appeal the Board affirmed the examiner's rejection. On appeal from the decision of the Board affirming the final rejection under § 121, the

Court of Customs and Patent Appeals (In re Haas II) reversed on the authority of In re Weber and held that "§ 121 does not provide a basis for the rejection of a claim."

In Ex parte Holt, 214 USPQ 381 (Bd. App. 1982), the Board of Appeals followed In re Weber and In re Haas II and granted relief to the Appellant on the basis that 35 U.S.C. § 121 does not give the Patent Office the authority to reject or otherwise refuse to examine a claim. The Board declared, "It is clear from Haas I that regardless of the language employed by the examiner, the refusal to examine a claim is, in effect, a rejection of that claim." (Emphasis added.)

In light of In re Weber and In re Haas, the Patent and Trademark Office revised restriction practice with respect to generically claimed inventions. The proper procedure for restricting a generic claim is delineated in § 803.02 of the M.P.E.P. In this regard the Appellants direct the Board to M.P.E.P. § 803.02, paragraphs 4 and 5, which states:

"As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the rejected claims would be made final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." (Emphasis added.)

Hence, the examiner may require an applicant to provisionally elect a species for examination. If the elected species is ultimately found patentable. Then the examination is extended to the provisionally withdrawn subgenera. If, on the other hand, the elected species is found unpatentable, the generic claim and claims to the elected species are rejected and claims to the non-elected subgenera are withdrawn from further consideration. The applicant may

overcome this rejection by amending the generic claim to exclude the unpatentable species. If after reconsideration of the amended claim a second species is found unpatentable, the claim is rejected and the action is made final. Thus, the prior art search is not extended unnecessarily and the applicant's invention, as he or she contemplates it, is examined on the merits.

To the extent that the Applicants' interpretation of the Restriction Requirement is correct, then the Applicants elect Group I for examination without traverse. To the extent that the Applicants' interpretation of the Restriction Requirement is not what the Examiner had intended and to the extent the Examiner had anticipated that the Applicants would amend their generic claims so as to excise non-elected subject matter prior to having such subject matter examined on the merits, then for reasons stated above the Applicants respectfully request that the Restriction Requirement be withdrawn or amended. The Applicants' respectfully request that the Examiner state, unequivocally, which interpretation of the restriction requirement is intended.

Respectfully Submitted,

12 October 2001
Date

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